

Remarks

Claims 1 and 5-9 have been rejected over the Walton reference pursuant to 35 USC 102(e)(2) [Patent granted on an application filed before the date of invention by the current Applicant]. Walton, which issued October 26, 2004, was filed on November 27, 2002. Walton's effective date as a reference is before the September 10, 2003, filing date of the current application, which is also the presumptive date of Applicant's invention. As demonstrated by the accompanying Rule 1.131 declaration, however, Applicant's date of invention was in fact before Walton's filing date and, therefore, Walton is disqualified as a reference.

Applicant's Date of Invention

The Rule 1.131 declaration sets out the chronology of the instant invention by Applicant. The invention was conceived in 1998. [Declaration ¶ 3]. Applicant proceeded diligently to refine her invention and create the databases necessary to implement the steps of the inventive method. In February 2001 Applicant transmitted to her attorney a draft specification that set out all the steps of the inventive method. [Declaration ¶ 6]. Applicant implemented the claimed method and provided a resulting aligned instructional intervention plan for a pilot study at Minneapolis Public Schools, starting in mid-2001. This included an aligned instructional plan for state language arts benchmarks delivered to Bryn Mawr Elementary School on September 10, 2001. [Declaration ¶ 8]¹. This constituted actual reduction to practice. The results of the use of Applicant's method were analyzed over a two-year period by McREL. [Declaration ¶ 7].

The Declaration and the foregoing demonstrate conclusively that Applicant's date of invention was before the Walton filing date.

Applicant and Walton Do Not Claim the Same Invention

Rule 1.131 cannot be used to antedate a reference where the application and the reference claim the same invention. In the present case, Applicant and Walton do not claim the same invention.

In the first instance, Applicant and Walton claim different statutory subject matter. Applicant claims a method of aligning instructional strategies to desired knowledge, while Walton claims an apparatus, namely a computer readable medium containing operating

¹ Applicant did not permit the school or the school district to practice her method. She applied the method herself and delivered the resulting aligned instructional plan to the school.

instructions² [Walton, Col 20-26, claims 1-34]. Even if we were to ignore this difference, the “steps” programmed into Walton’s medium are not the same as the steps in Applicant’s method.

Walton has four independent claims, claims 1, 22, 29 and 31. Claim 1, for example, recites selecting a goal with objectives and skills and assigning the objective to one of the “sensory cognitive processing categories” and also assigning it to an “information processing stage class” [Col 20, l 22-26]. Applicant, on the other hand, classifies knowledge objections by knowledge domain (procedural or declarative) and by brain processing function (self, metacognitive and cognitive).

Although the terminology of the two inventions may appear similar, they refer to very different technologies. Walton’s “sensory cognitive processing categories” refer to the type of sensory stimulation required for each of the objectives [Col 9, l 27-45]. Sensory stimulation refers to stimulating a particular brain cortex (in the occipital lobe, temporal lobe or parietal lobe) based on auditory, visual, somatic sensory or associational inputs [Col 6-8]. Learning objectives are classified into one of these sensory categories (see Fig 4, classifying into visual, auditory and associational). A curriculum method appropriate to the sensory category is then selected [Col 15 l 63 to Col 16 l 32 and Fig. 9].

Neither of Applicant’s classification steps is remotely similar to Walton’s sensory stimulation analysis. Knowledge domain refers to procedural knowledge and declarative knowledge, as described in the writings of Robert Marzano and detailed in the specification [¶ 0024-0051]. Brain processing function specifically refers to the self, cognitive and metacognitive systems, a taxonomy known in the art and expounded by Manzano. This is also detailed in the specification [¶ 0052-0057].

All four of Walton’s independent claims recite a limitation including a classification by sensory cognitive processing categories [Claim 1, Col 20, l 23-25; Claim 22, Col 22, l 49-51; Claim 29, Col 24, l 9-11; Claim 31, Col 24, l 38-40]. No claim that includes sensory cognitive processing classes reads on Applicant’s invention. Consequently, the two do not claim the same invention.

² The Walton patent is titled, “System and Method . . .,” but there are no method claims. The claims determine whether two instruments “claim the same invention.”

The Accompanying Rule 1.131 Declaration is Timely

This is an After Final reply pursuant to Rule 1.116. The accompanying Declaration may be admitted upon a showing of good and sufficient reason (1) why it is necessary and (2) why it was not earlier presented.

With respect to (1), Applicant submits that the necessity is manifest. The declaration antedates the primary reference and clears the way for allowability. With respect to (2), the Walton reference was still secret at the time Applicant filed the instant application and was thus unknown to Applicant. The Examiner cited Walton as a new grounds for rejection (mooting Applicant's prior arguments) but issued a Final Action because prior amendments necessitated a new search. The information in the Declaration was not relevant to any issue in the prosecution until the Final Action was received. This is a good and sufficient reason why it was not earlier presented.

Conclusion

The information provided in this Reply removes Walton as a prior art reference. In the absence of Walton, the remaining references do not disclose the limitations of the instant invention. (Applicant does not agree that Walton is an invalidating reference, even if it were prior art. But these considerations are moot with the antedating of Walton). Therefore, Applicant respectfully submits that this application is in condition for allowance and requests that the final rejection be withdrawn and the application be allowed.

Respectfully submitted,

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February 8, 2007

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